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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,727	03/11/2004	Tracey A. Morley	17516-008120US	4983
7590	11/14/2006		EXAMINER	
Patent Dept. Intuitive Surgical, Inc 950 Kifer Road Sunnyvale, CA 94086			ROANE, AARON F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/798,727	MORLEY ET AL.
	Examiner	Art Unit
	Aaron Roane	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 March 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 61-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 61-77 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>3/11/04 &amp; 5/28/04</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION*****Claim Objections***

Claim 73 is objected to because of the following informalities: claim 73 depends directly from claim 70 and recites “a third axis.” Claim 70 does not recite a “first axis” and “second axis.” However, claim 72 does recite a “first axis” and “second axis.” In order to provide an initial examination the examiner will interpret claim 73 as depending directly on claim 72.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 61-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallace et al. (USPN 6,394,998 B1) in view of Parins et al. (USPN 5,908,420) or Eggers et al. (USPN 5,891,142) in further view of Zvenyatsky et al. (EP 0584787 A1).

Regarding claims 61, 63-67, 70 and 72-75, Wallace et al. disclose an electrosurgical instrument comprising: a first body (14.1), a second body (52) rotatably coupled to the first body about a first axis (axis defined by 54), first and second end effectors (58.1 and 58.2) rotatably coupled to the second body about a second axis (axis defined by 60), wherein the first and second axis are substantially orthogonal to each other, and a third axis (14.2) extends longitudinally down the first body, wherein the first body, second body and end effectors are rotatable about the third axis, see starting on col. 6, line 64 and ending on col. 8, line 49 and figures 1-7. Wallace et al. also disclose another embodiment wherein the end effectors are provided with a removably mounted electrode, see starting on col. 4, line 46 and ending on col. 5, line 14, and starting on col. 16, line 30 and ending on col. 17, line 11. Wallace et al. fail to explicitly disclose that the a) proximal portions of the first and second end effectors comprise a nonconductive body, b) the distal portions of the first and second end effectors comprise a substantially triangular shaped conductive grip body for gripping a target tissue, c) a first conductive lead coupled to the first end effector and a second conductive lead coupled to the second end effector and d) that the first and second leads are attachable to a power source to deliver energy to the distal portions of the first and second end effectors. In regards to a), it is known in the art that bipolar forceps' jaws must be electrically isolated from each and that this is accomplished by providing the first and second jaws with proximal portions comprised of nonconductive material. As examples, Parins et al. disclose electrosurgical forceps devices and teach providing the proximal portions of the

first and second jaws (60 and 62) with nonconductive material (86 and 87 respectively) in order to provide the desire electrical insulation, see col. 3-4 and figures 4-9, while Eggers et al. disclose an electrosurgical forceps device and teach providing the proximal portions of the first and second jaws (112 and 114 and their analogous counterparts in other embodiments) with nonconductive material (117 and 119 respectively and their analogous counterparts in other embodiments) in order to provide the desire electrical insulation, see col. 5-19 and figures 1-15. While aspects c) and d) are inherent in any bipolar forceps device and disclosed by both the Parins et al. and Eggers et al. patents. Finally, regarding aspect b), Zvenyatsky et al. disclose an electrosurgical forceps device and teach providing each of the first and second jaw members with a distal triangular gripping portion (330) having teeth (ridges) (332) and an opening (334) in order to grip soft tissue, see col. 10 and 18-19 and figures 22-25B. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Wallace et al., as is known in the art and taught by both the Parins et al. and Eggers et al., to providing the proximal portions of the first and second jaws with nonconductive material in order to provide the desire electrical insulation, and further taught by Zvenyatsky et al., to provide each of the first and second jaw members with a distal triangular gripping portion having teeth and an opening in order to grip soft tissue.

Regarding claims 62 and 71, Wallace et al. disclose a robotic interface (11), see starting on col. 6, line 64 and ending on col. 7, line 17 and figures 1 and 2.

Regarding claims 68 and 76, Wallace et al. disclose the second body comprises a pulley assembly (58.5, 68 and 70), wherein a plurality of drive cables (C1, C2, C3 and C4) interact with the pulley assembly and the non-conductive bodies to move the second body and the first and second end effectors, see figures 5-7 and 10.

Regarding claims 69 and 77, Wallace et al. in view of Parins et al. and in further view of Zvenyatsky et al. disclose the claimed invention, see Parins et al. figures 4-9.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.R. *A.R.*  
October 17, 2006

*Leah C. Scherzer*  
Leah C. Scherzer  
Patent Examiner